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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,629	10/01/2003	Herbert Bachler	36162	7839
116 7590 12/10/2008 PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108				
EXAMINER SAUNDERS JR, JOSEPH				
ART UNIT 2614		PAPER NUMBER		
MAIL DATE 12/10/2008		DELIVERY MODE PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/676,629

Applicant(s)

BACHLER, HERBERT

Examiner

Joseph Saunders

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 7, 9, 10 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 7, 9, 10, 12 and 13 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 16, 2008 has been entered. Claims 1 – 3, 7, 9, 10, 12 – 14 are currently pending and considered below.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1 – 3, 7, 9, and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 1 recites the new limitation “a switching unit” and later states that “said switching unit comprising a sensing unit”. However, the specification discloses the hearing system (Figure 1) comprising the

sensing unit 9 and not the switching unit (understood to be switch labeled 15 in Figure 1) comprising the sensing unit. Appropriate clarification and correction is necessary.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 – 3, 7, 9, 10, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hohmann et al. (US 7,013,015), hereinafter Hohmann, in view of Dr. Ross on Hearing Loss Acoustic Feedback Control, hereinafter Ross.

Claim 1: Hohmann discloses a hearing system comprising at least one ear-applicable hearing device with an input acoustical/electrical converter arrangement (Figure 1 and 2), a switching unit (signal processing unit 2) being switchable by an individual to control said hearing device in a first stable operating status as desired by said individual (normal operating status with narrow-band notch filters deactivated) or in at least one second stable operating status as desired by said individual (operating status with narrow-band notch filters activated for reducing feedback), so as to adapt said hearing system by said individual to a respectively desired operating status, said switching unit comprising a sensing unit sensing operating stability and operating instability of an acoustical feedback loop including said hearing device applied to said individual

(oscillation detector 15, comparison unit 16, and control unit 17), said sensing unit controlling switch-over from said one desired to said at least one second desired operating status whenever instability of said feedback loop is sensed (Column 6 Lines 6 – 40).

Hohmann does not explicitly state that said instability is willingly established by said individual at a desired moment and removed by said individual at a second desired moment so as to control said change over by the willingly applied instability during the time span between said second and said first moment.

Further, it is again noted that the limitations of said instability being willingly established by said individual so as to control said change over from a first to a second desired operating status applies to how the user operates the hearing aid and not to the hearing aid system itself. Regardless, Ross discloses in a hearing aid, "anything that facilitates the feedback cycle will increase the chances of feedback, such as placing one's hand next to the hearing aid (often while adjusting the volume control), raising one's coat collar or pulling down a stocking cap on a cold day, standing too close to a wall or resting one's head on a pillow, and using a telephone without a telephone coil. In these cases, the aid may be set just below the feedback point, but with the addition of these enhancement factors enough sound is reflected back into the microphone for the feedback cycle to commence," last bullet on page 2. Ross then continues to teach that when feedback occurs, it is desirable to eliminate or reduce its occurrence.

Therefore, given the teachings of Hohmann regarding a hearing aid designed to reduce feedback; it would have been obvious to one of ordinary skill in the art at the

time of the invention given the teachings of Ross that during the use of Hohmann's hearing aid for an individual to willingly establish an instable condition (e.g. while adjusting the volume control), thereby causing the hearing aid of Hohmann to change operating status and meeting the limitations of the claimed invention.

Claim 2: Hohmann and Ross disclose the system of claim 1, wherein said instability of said feedback loop is established by said individual by manually applying a member adjacent to and/or to said hearing device (Ross, last bullet on page 2).

Claim 3: Hohmann and Ross disclose the system of claim 2, wherein said member is a hand (Ross, last bullet on page 2).

Claim 7: Hohmann and Ross disclose the system of claim 1, Hohmann further comprising a second hearing device (hearing device 11') operationally connected to said at least one ear-applicable hearing device (hearing device 11) by a communication link (signal path 17), wherein said first and second desired operating status comprise status of at least one of said hearing devices and said communication link (hearing device 11 and 11' have operating statuses pertaining to notch filters activated and notch filters deactivated at different frequencies and the operating status of each hearing aid device is conveyed on the communication link for comparison, Column 6 Lines 11 – 18).

Claim 9: Hohmann and Ross disclose the system of claim 1, wherein said at least one hearing device is an outside-the-ear hearing device or an in-the-ear hearing device or a completely-in-the-canal hearing device ("The invention can be employed in all standard types of hearing aid devices, for example, given hearing aid devices to be worn behind the ear, hearing aid devices to be worn in the ear, implantable hearing aid devices or pocket devices," Hohmann Column 3 Lines 18 – 21).

Claim 10: Hohmann and Ross disclose the system of claim 1, wherein said at least one hearing device is a hearing aid device ("The invention can be employed in all standard types of hearing aid devices, for example, given hearing aid devices to be worn behind the ear, hearing aid devices to be worn in the ear, implantable hearing aid devices or pocket devices," Hohmann Column 3 Lines 18 – 21).

Claim 12: Hohmann discloses a method for manually controlling a hearing system with a hearing device, to switch over from one desired operating mode of the hearing device to at least one other desired operating mode of the hearing device, comprising the steps of:

providing the hearing device (Figures 1 and 2), wherein the hearing device is worn by an individual ("The invention can be employed in all standard types of hearing aid devices, for example, given hearing aid devices to be worn behind the ear, hearing aid devices to be worn in the ear, implantable hearing aid devices or pocket devices," Column 3 Lines 18 – 21); and changing from the one desired operating mode of the

hearing device to the at least one other desired operating mode of the hearing device upon the hearing device sensing the instable operating mode (changing from normal operating status with narrow-band notch filters deactivated to an operating status with narrow-band notch filters activated for reducing feedback, Column 6 Lines 6 – 40).

Hohmann does not explicitly state willingly establishing, by the individual, an instable operating mode of the hearing device. However, Ross discloses in a hearing aid, "anything that facilitates the feedback cycle will increase the chances of feedback, such as placing one's hand next to the hearing aid (often while adjusting the volume control), raising one's coat collar or pulling down a stocking cap on a cold day, standing too close to a wall or resting one's head on a pillow, and using a telephone without a telephone coil. In these cases, the aid may be set just below the feedback point, but with the addition of these enhancement factors enough sound is reflected back into the microphone for the feedback cycle to commence," last bullet on page 2. Ross then continues to teach that when feedback occurs, it is desirable to eliminate or reduce its occurrence.

Therefore, given the teachings of Hohmann regarding a hearing aid designed to reduce feedback; it would have been obvious to one of ordinary skill in the art at the time of the invention given the teachings of Ross that during the use of Hohmann's hearing aid for an individual to willingly establish an instable condition (e.g. while adjusting the volume control), thereby causing the hearing aid of Hohmann to change operating status and meeting the limitations of the claimed invention.

Claim 13: Hohmann and Ross disclose the method of claim 12, wherein the instable operating mode is established by manually applying a member adjacent to and/or to said hearing device (Ross, last bullet on page 2).

Allowable Subject Matter

6. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

7. Applicant's arguments filed September 16, 2008 have been fully considered but they are not persuasive.

8. Applicant's arguments with respect to claims the system claims 1 – 3, 7, 9, and 10 are not persuasive because as stated in the rejection, " Further, it is again noted that the limitations of said instability being willingly established by said individual so as to control said change over from a first to a second desired operating status applies to how the user operates the hearing aid and not to the hearing aid system itself". In other words, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. This issue was also previously discussed and noted in the Examiner Interview Summary dated January 3,

2008, which states "It was explained to Applicant's attorney that the proposed limitations apply to how the user operates the hearing aid and not on the hearing aid system itself rendering the limitations more suitable for the method claim since, from the point of view of the hearing aid system, the device of Hohmann et al. would operate in the same manner by varying operating parameters of the hearing aid based on acoustic feedback".

9. Applicant's arguments with respect to claims the method claims 12 and 13 are not persuasive because, while as stated by Applicant "*Claim 12 recites "switch over from one desired operating mode of the hearing device to at least one other desired operating mode of the hearing device" and "changing from the one desired operating mode of the hearing device to the at least one other desired operating mode of the hearing device."*, " claim 12 does not explicitly state "*The desired operating modes can be operating modes of the hearing system which are customarily controlled by the wearer (e.g., a sleep mode, active mode, transmission characteristic A, transmission characteristic B, etc.) The operating modes are different and would be desirable to the individual according to his instantaneous needs, and the individual can control a change of operating modes.*". In other words, the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). While Applicant argues, "*Hohmann's system, however, attempts maintain a stable operating status without a change that is apparent to the individual.*," the statement alone is an acknowledgement

that Hohmann indeed discloses the claimed *"switch over from one desired operating mode of the hearing device to at least one other desired operating mode of the hearing device" and "changing from the one desired operating mode of the hearing device to the at least one other desired operating mode of the hearing device,"* and again it is noted that whether the change is apparent to the user or not is irrelevant since this feature is not recited in the rejected claim(s).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Saunders whose telephone number is (571) 270-1063. The examiner can normally be reached on Monday - Thursday, 9:00 a.m. - 4:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. S./
Examiner, Art Unit 2614
/CURTIS KUNTZ/
Supervisory Patent Examiner, Art Unit 2614